

REMARKS

The September 1, 2005 Official Action and the references cited therein have been carefully reviewed. In view of the amendments presented herewith and the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset, Applicants are resubmitting a copy of the priority document in accordance with the Examiner's request.

Claims 1-3, 5-10, 28, 30, 31 and 45 stand rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, the Examiner is unclear as to the metes and bounds of these claims.

At page 3 of the Official action, the Examiner has rejected claim 1 as allegedly anticipated by US Patent 5,583,016 to Villeponteau et al.

The foregoing constitutes the entirety of the objections and rejections raised in the September 1, 2005 Official Action. In light of the present claim amendments and the following remarks, each of the above-mentioned rejections under 35 U.S.C. §§112, second paragraph, and 102 is respectfully traversed.

THE METES AND BOUNDS OF CLAIMS 1-3, 5-10, 28, 30, 31, AND 45 AS AMENDED ARE CLEAR TO ONE OF SKILL IN THE ART

The Examiner has rejected the above-identified claims asserting that the skilled person cannot determine the relationship of SEQ ID NO: 36 in Figure 4a to the isolated promoter sequence.

The relevant inquiry in determining whether a given claim satisfies the requirements of 35 U.S.C. §112, second paragraph,

is whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity such that the metes and bounds of the claimed invention are reasonably clear. In re Moore, 169 U.S.P.Q. 236 (CCPA 1971). Applicants respectfully submit that with respect to claims 1-3, 5-10, 28, 30-31, and 45 of the present application, such inquiry must be answered in the affirmative.

The definiteness of claim language may not be analyzed in the abstract, but must be considered in light of the teachings of the prior art and of the particular application disclosure, as it would be interpreted by one having ordinary skill in the art. In re Moore, supra.

The specification clearly states that Figure 4a shows the sequence of the human telomerase gene 5' flanking regions. The present inventor has identified the minimal promoter region as well as longer 5' flanking sequences which initiate transcription of an operably linked coding sequence. The skilled person is well aware of the labeling scheme conventionally employed when describing 5' flanking promoter sequences. The transcription initiation site is typically given a +1 designation and all regions 5' of the start site are given a - number designation. Accordingly, a sequence comprising at least 272 base pairs upstream of and at least 69 nucleotides downstream of the start site would correspond to nucleotides 527 to 867 of SEQ ID NO: 36.

The skilled person having the sequence listing and Figure 4a before him could readily determine the metes and bounds of the claims. However, in order to expedite prosecution of the present application, the claims have been amended to recite the nucleotide boundaries in SEQ ID NO: 36 of the claimed promoter sequences. It is respectfully submitted that the foregoing amendments serve to remove any perceived ambiguity from the claims. Accordingly, the rejection under 35 U.S.C. §112, second

paragraph is inappropriate and should be withdrawn.

**THE CLAIMS AS AMENDED ARE NOT ANTICIPATED BY US PATENT 5,583,016
TO VILLEPONTEAU**

In order to constitute evidence of lack of novelty under 35 U.S.C. §102(b), a prior art reference must identically disclose each and every element of the rejected claim. In re Bond, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

The Examiner has rejected claim 1 asserting that it is anticipated by '016 patent to Villeponteau. Specifically, the Examiner refers to SEQ ID NO: 3 of the '016 patent. Claim 1 has been amended to recite a promoter sequence consisting of a promoter sequence of SEQ ID NO: 36 (hProm867), a sequence having 95% homology to SEQ ID NO: 36 or a functional fragment thereof. Inasmuch as SEQ ID NO: 3 of the '016 patent is at least 600 base pairs longer, it cannot be reasonably maintained that the invention as presently claimed is identical to that disclosed by Villeponteau. Applicants appreciate that the term "comprising" is open language. However, attached hereto is a sequence alignment of the sequence encompassed by claim 1 and the Villeponteau sequences. As can be seen from the alignment, there are also subtle sequence differences between SEQ ID NO: 36 (hProm867 and hProm697 contained therein) and the Villeponteau sequence.

New claim 46 and dependent claims 47 through 52 have been added. It is submitted that given the sequence differences in hProm 867 and hProm697 applicants are entitled to use open comprising language. Support for the new claims can be found in the claims as originally filed.

In light of the foregoing remarks, sequence alignment and amendment, it is submitted that the present claims are novel over Villeponteau. Accordingly, the rejection is untenable and should

be withdrawn.

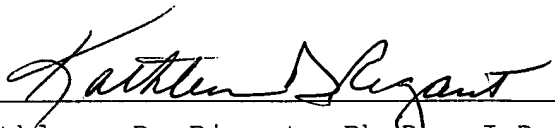
Claim 1 has been further amended to include functional fragments of SEQ ID NO: 36. Support for this amendment can be found in Figure 4a where the functional promoter fragments are clearly indicated. Claims 1, 2, 30 and 31 have also been amended to recite promoter sequences which have 95% homology to the sequence encompassed by the claim, the fragment or homologous sequence retaining promoter function. Support for this amendment can be found at page 9, lines 5-10.

CONCLUSION

In view of the amendments, sequence alignment and remarks presented herein, it is respectfully urged that the rejections set forth in the September 1, 2005 Official Action be withdrawn and that this application be passed to issue. In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to telephone the undersigned attorney at the phone number given below.

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Enclosures: Sequence alignment
Priority document